

No. 2996.

United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT.

Wilson & Willard Manufacturing Co.,
Appellant,

vs.

Union Tool Company, et al.,
Appellees.

PETITION FOR REHEARING.

FREDERICK S. LYON,
Solicitor for Appellee.

FILED

APR 1 1907

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PETITION FOR REHEARING.

The complainants and appellees feeling themselves aggrieved by the decision herein rendered by this Honorable Court on February 11th, 1918. come now and respectfully petition the court for a rehearing of this cause upon the grounds hereinafter stated.

I.

Misconception by the Court of the Facts in Connec-
tion With the Prosecution of the Application for
the Patent in Suit.

In the court's opinion, on page 11, the court says:

"The importance of this point is emphasized by the record which shows that Double cancelled his

claim No. 8 and substituted claim No. 7, limited his specification and amended his claims to provide for opposite parallel bearing faces upon his hollow slotted extension.”

The claim 8 referred to by the court as cancelled apparently is claim 8 of the amendment of September 13th, 1902, and appears on page 245 of the “Book of Exhibits” as follows:

“In an underreamer the combination of a hollow mandrel, a slip-carrying rod in said mandrel, slips connected to said rod, and means for tilting said slips.”

This claim 8 was rejected on the patent to Brown, 687,296. At the same time claim 8 of the patent (10 of said amendment) had been allowed. No amendment was made to the specification to secure the allowance of such claim 8 of the patent at the time of cancelling the original claim 8, and there was made no limitation of the specification to secure such allowance which can be referred to the cancellation of such cancelled claim 8. Analysis of such cancelled claim 8 shows that it calls solely for the following elements:

1. A hollow mandrel;
2. A slip-carrying rod in said mandrel;
3. Slips connected to said rod; and
4. Means for tilting said slips.

It is seen in this connection that this claim does not even call for a structure wherein the so-called slips or cutters project from the bottom of the mandrel. No reference whatever is made to the mandrel or body being provided with open slipways, nor are the slips or

cutters called for as having shanks extending into such open slipways. Furthermore, as set forth, this cancelled claim 8 does not call for the expanding surfaces on the slips such as used by both the Double and the Wilson reamers, and such, for example, as set forth in claim 6 of the patent in suit, original claim 7 of the application as filed.

The cancellation of this claim 8 estops appellees from claiming the same breadth of scope for subsequently allowed claims as would be given to this cancelled claim. But when the open slipway construction is brought into the claims, as in claim 1, for example, it does not require or estop the court from giving effect to a claim for such open slipway construction and require the court to limit such claim to each and every exact detail of construction not essential to an open slipway construction. *The record shows that the Double invention was the first to utilize tilting slips having shanks extending into open slipways in combination with a body provided with open slipways therefor.* The Double invention was not limited to the initial release referred to by the court.

A very careful reading of the opinion of this court seems to disclose that the court has misunderstood the facts. On page 9 of the opinion the court says:

“The record shows that this operation causes what is called ‘plunging’ and which is obviated in the Wilson underreamer because of the fact that the cutters there collapse on the beginning of the downward movement.”

The "operation" so referred to by the court is the initial release or collapse of the cutters *when the underreamer is to be withdrawn from the well*. It is submitted that the court has pointed out a possible improvement of the Wilson underreamer upon the Double invention and it is also submitted that this does not deny that the substantial principle and interrelation of parts of the Double invention has also been used in the Wilson reamer. None of the claims in suit in any manner call for such an interrelation of the parts *as would limit them to the initial expansion feature thus referred to by the court*.

It is furthermore submitted that the paragraph of the court's opinion commencing at the bottom of page 8 is in error. The feature of the Double invention of providing for the contact of the casing-shoe with the upper end portions of the shanks of the cutters close to the pivot point of the cutters on the spring-actuated rod is included in claim 1 most clearly and certainly and in the following language: "And upwardly and inwardly sloping dovetail slipways beneath said shoulders," the same being called for in combination with "dovetail tilt-slips playing in the slipways." This is not for *"the sudden collapse of the cutters,"* but, *on the contrary, is to so interrelate the leverage exercised by the end of the pipe of the casing-shoe on the shanks of the cutters to the pivot point of the cutters on the spring-actuated rod so as to secure the maximum amount of inward movement of the lower or cutting ends of the cutters by the maximum amount of the inward movement of the upper ends of the cutter*

shanks caused by the pressure of the casing-shoe. It is this feature that was new in the Double invention and was one of the novel interrelations produced by Mr. Double. The question of quick collapse was not involved; on the contrary, it was a question of a sufficient movement of the cutting ends of the bits or cutters to bring them inward a sufficient distance to permit their withdrawal into the well pipe or casing, and to hold them in such position that the outer edges thereof would not contact into the inner surface of such casing or pipe wells while the reamer was being lowered through the casing.

In the prior art there was no underreamer which had the *open slipways* so that this contact of the casing-shoe could be close to the pivot point. Whether the Wilson initial collapse be an improvement upon the Double initial collapse or release is not material to this feature, and such initial collapse is in no manner an imitation expressed in any of the claims of the Double patent. On the contrary, the claims are broadly expressed so as to avoid any limitation to questions of initial collapse.

The attention of the court is further directed to the fact that instead of the Double claims or specifications referring in any manner to such initial collapse, both the specification and claims are entirely silent with respect thereto. It is logically impossible, therefore, to hold that the Double patent, by its specification or claims, *shows any intent on behalf of Mr. Double to limit either his invention or his claims* to such initial collapse and there is nothing in the proceedings in the

patent office which shows any such intention. Nor is there anything in the prior art which requires or required such limitation. This court says in its opinion, page 10:

“The Double underreamer should have been held to have been a step in the art, carried forward by Wilson’s invention.”

The court here recognizes and adopts appellees’ position, but has apparently misunderstood a number of the contentions raised by the appellant and their application to the controlling facts in the case. The question of difference in initial collapse or release of the cutters was not the novel feature of the Double invention, and apparently the court has fallen into further misapprehension as to the mechanics of the case, for in the opinion, page 8, it says:

“The tilting action of the cutters of the Double device, due to the presence of the spreading member or downward extension between the cutters at the time of collapsion, is not to be had in the Wilson reamer, for, as already indicated, there is no part of the mandrel between the cutters at the time of collapsion upon which there could be a tilting.”

The tilting action of the Double cutters and the tilting action of the Wilson cutters *is shown to be the same* by referring to the Wilson patent Fig. 1, Book of Exhibits, page 278. Notice the position of the shanks of the cutters as shown in dotted lines. The upper ends of these cutters have moved away from the vertical portion of the rod 5'. At this time the parts are shown

in their extreme collapsed positions. The same is true in the extreme collapsed positions of the Double bits and cutters when the shoulders 18 of the Double cutters have slid off below the end of the reamer body. (See Fig. III of Double patent, Book of Exhibits, page 258.) In both the Double reamer and in the Wilson reamer the tilting action of the cutters is substantially identical,—if not absolutely identical. In neither is this tilting action in any manner due to the presence of any spreading member or downward extension between the cutters at the time of collapsion. On the contrary, in the specific or preferred embodiment of the Double invention set forth in the Double patent, the cutters are cut away at 26, above the shoulders 18, so that this collapsing is permitted without the cutters in any manner touching the spreading member or downward extension, *in the same manner as in the Wilson device*. There is, therefore, no part of the body of the reamer which takes part in this collapsing action. If the court, in the extract just quoted from its opinion, by the word “mandrel” referred to the body of the reamer, the foregoing observation shows the error in mechanical fact. If, however, the term mandrel was used to identify the spring-actuated rod 5' of the Wilson reamer, it is manifestly in error as the head of such rod is, of course, between the cutters at the time of collapsion and it is upon this head that such cutters tilt. This brings us to a consideration of the amendment made to the Double specification referred to by the court in its opinion. This amendment was by the insertion of the matter appearing in lines 75-87 of the

Double specification, Book of Exhibits, page 260. (See amendment B, last paragraph on page 249 of the Book of Exhibits.)

The key-seats or sockets 18 in the shanks of the Wilson bits are clearly "*somewhat larger*" than the key or head 5 of the rod 5'. (See Book of Exhibits, pages 278, 279.) If this were not so the positions illustrated in dotted lines in figure 1 would be impossible. The further explanation thus given of the Double invention by this insertion to the Double specification is fully found in the Wilson device. This amendment, therefore, cannot form a limitation which will permit the Double underreamer, a step carried forward by Wilson's invention, to escape infringement of the Double patent.

This court, on page 6 of its opinion, apparently misconceives the mechanical facts in relation to the action of the tilting collapse of the Wilson cutters. The court says (about the middle of the page): "*The shoulders * * * do not permit a sliding action of the shanks of the cutters upon the suspension means to permit tilting.*" This is shown to be error by reference to Fig. 1 of the drawings of the Wilson patent. It will be demonstrated to be error by reference to a Wilson reamer, but extreme care must be taken as the true action of the Wilson cutters on the head of the rod 5' cannot be seen unless the spring-actuated rod is in position and exerting its tension.

The only other amendment to the Double specification was to insert the descriptive words "with oppositely arranged parallel bearing facts." (Lines 50, 51, page 1 of the Double patent, Book of Exhibits, page 260.)

More readily ascertained by the insertion shown on page 232 of the Book of Exhibits, and the minor changes also shown in the small print on pages 232, 233 and 326 of the Book of Exhibits. These were all immaterial. The only addition to the specification or change in it that can be claimed as a limitation is the insertion which has just been quoted, and it is a true description of the intrust bearings which are formed at the lower end of the outward extensions. These intrust bearings are "oppositely arranged parallel bearing faces." They could not in a description be described as anything else and be accurately described, but they do not show an intention to limit the patent to such preferred form of construction. Furthermore, these oppositely arranged parallel bearing faces are the intrust bearings only and correspond as intrust bearings with the intrust bearings 9 on the prongs of the Wilson underreamer. (See Book of Exhibits, page 278.)

It is only by reading into the Double claims features of construction shown in the Double patent drawings, which are not set forth in the claims, that the Wilson reamer can be differentiated from the preferred embodiment of the Double invention by means of the initial collapse and by reason of the difference between straight parallel bearing faces and their relation to upwardly inclined dove-tailed ways and slightly tapered oppositely arranged bearing faces 9 of Wilson's patent, and the straight dove-tailed ways. So far as the broad Double invention is considered, i. e., being the first to utilize the open slipway construction of the body and

the cutters with shanks extending into the slipways, shanks and slipways being dove-tailed, and the end portion of the reamer provided with oppositely arranged bearing faces on which the cutters bear, the two devices are substantially the same.

It is not intended in this petition to point out every apparent mechanical error in the opinion filed, nor is it the purpose or intent hereof to criticize such opinion, but it seems therefrom that appellants have not succeeded in clearly bringing before the court the true mechanical facts and that the court has misunderstood the same. As further evidence thereof attention is called to page 7 of the court's opinion in which it is

“In the Wilson cutters there are not inward projections which slide upon the downward extensions of the mandrel, nor are there the upper faces of the inward projections sloping downwards. In fact, the Double cutter does not contain shanks; whereas, the Wilson cutter has a cutter-head and a long shank.”

In the first part of the matter just quoted the court has apparently compared the Wilson cutters with the Double cutters and refers to the shoulder 18 of the Double patent, which shoulder causes the expansion when the upper surfaces of such shoulder contacts with the inclined or rounded end of the body. Referring again, for convenience, to the Book of Exhibits, pages 278 and 279, and to the Wilson patent, the shoulders 16 are rounded for the purpose of contacting with the inclined lower end surfaces 17 of the body and the surfaces 4³ *extend inward. That is face in-*

ward, for the same purpose as does the surfaces 18 of the Double bit, the surfaces 4³ and 18, respectively, being the intrust bearings of the cutters. Not only are these facts true, but it will be noted from the drawings of the Wilson patent that these surfaces 4³ slope downwardly and correspond in such slope to the slope of the surface 18 of the Double patent. (Book of Exhibits, page 259, Fig. XII.)

In the last quotation from the court's opinion, the statement that the "Double cutter does not contain shanks" is shown to be a mechanical error by reference to the drawings of the Double patent or to any of the Double reamers. In fact it is claimed that the notch 26 in the shanks of the Double cutters was the weakness of the cutters.

It is believed that the foregoing illustrate the necessity of a reargument and rehearing of this case in order to do substantial justice. It is believed that the court has been permitted to form an erroneous impression of the mechanics of the case, and for each of these reasons a rehearing is requested.

FREDERICK S. LYON,
Solicitor for Appellee.

